PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#23
M.G.J
4/6/98

In re application of

Eric A. JOHNSON et al.

Appln. No. 08/458,019 Group Art Unit: 1808

Filed: 1 June 1996 Examiner: H. Lilling

For: PROCESSES FOR IN VIVO PRODUCTION OF ASTAXANTHIN AND PHAFFIA RHODOZYMA YEAST OF ENHANCED ASTAXANTHIN CONTENT

entered
4/9/98

REQUEST FOR RECONSIDERATION

Assistant commissioner for Patents
Washington, D.C. 20231

Sir:

This Request for Reconsideration is in response to the Office Action mailed 1 December 1997. Attached hereto and herein incorporated by reference is a Petition for Extension of Time for a one-month extension making the due date for response 1 April 1998.

I. In item 17 on page 2 of the Office Action, claims 25-34 were rejected under the judicially-created doctrine of obviousness-type double patenting over U.S. Patent No. 5,356,810.

The rejection is traversed for the following reasons.

All there is common between the '810 patent and the instant application is a common inventor. However, the instant application and the cited patent are owned by different entities and thus, the '810 patent and the instant application are not commonly owned.

Accordingly, there is no unjustified extension of patent term for an owner.

The Examiner acknowledged that the instant application and the '810 patent do not claim the same invention. Clearly, the instant application claims a genus whereas the '810 patent is directed to a specific species.

Moreover, the '810 patent is not an effective reference against the instant application.

Therefore, applicants maintain that the only possible course of action the Examiner can pursue is to withdraw the rejection.

At that time, possibly the Examiner may need to consider whether an interference to determine priority of invention may be required because the only possible impact the '810 patent could have on the instant application arises under 35 U.S.C. §102(g).

Hence, applicants maintain that the rejection is improper and thus must be removed.

II. In item 19 on page 3 of the Office Action, claims 25-34 were rejected under 35 U.S.C. §112, first paragraph as the Examiner believes that additional strains of yeast must be obtained to demonstrate enablement.

The rejection is traversed for the following reasons.

The undersigned thanks the Examiner for making himself available for an interview where it was uncovered that the Rule 132 Declaration, which demonstrates reproducibility of the instant invention and provides data on additionally obtained strains enabling the scope of the claimed invention, which was previously filed could not be located in the Patent Office file wrapper.

In the Interview, the Examiner acknowledged that such a Declaration would overcome the rejection under 35 U.S.C. §112, first paragraph, as the data would clearly demonstrate reproducibility of the teachings of the instant specification.

Accordingly, attached hereto for the convenience of the Examiner is a second Rule 132 Declaration of Dr. Hiu which is substantially identical to the copy filed on 16 December 1993 in the parent application, U.S. Serial No. 067,797, the original of which was submitted in U.S. Serial No. 837,120.

The Examiner will find that the Declaration evidence demonstrates that the methods taught in the instant application were practiced to obtain a number of new strains of Phaffia producing the substantial amounts of astaxanthin as claimed.

In view thereof, withdrawal of the rejection is requested respectfully.